

REMARKS

Examiner's Rejections and Objections

The subject patent application is a continuation of U.S. Patent Application Serial No. 10/347,813 which was filed on January 21, 2003 and has presently received a Notice of Allowance from the U.S. Patent and Trademark Office. The purpose of this application is to seek claims on patentable aspects which were not emphasized in the earlier-filed '813 parent application.

In the last Office Action received during the prosecution of the '813 application, the Examiner rejected Claims 1-6, 12 and 21-25 under 35 U.S.C. §102(b) as being anticipated by the Gomez reference ("Gomez"). The Examiner further rejected Claims 7-11 under 35 U.S.C. §103(a) as being unpatentable over Gomez in view of the Koester reference ("Koester").

Claims 13, 14, 26 and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gomez in view of the Donahue reference. Lastly, the Examiner rejected Claims 15-20 under 35 U.S.C. §103(a) as being unpatentable over Gomez in view of the Donahue reference, Koester and the Casale reference.

As will be demonstrated below, it is respectfully submitted that the presently pending claims, and more particularly independent Claims 1 and 15, have been amended to incorporate certain features which are believed to be allowable, and thus

should share the same fate as the earlier-filed '813 parent application.

Summary of Applicant's Response

Applicant is concentrating upon original Claims 1-6 and 10-20. From those claims, independent Claims 1 and 15 were amended to incorporate allowable subject matters which are believed to overcome all of the relevant prior art references cited in the earlier prosecution.

Amended Independent Claims 1 and 15

Applicant has amended independent Claims 1 and 15 to incorporate distinguishable features which are believed to be novel and unobvious over the cited prior art of relevance.

Applicant's Present Invention

As specifically recited in amended independent Claims 1 and 15, the present invention is a decorative face mask which is used in conjunction with a head-wear (e.g., sports cap) for rallying a sports team during a sporting event (e.g., baseball game). Within such broad description of the present invention, the decorative face mask combined with the head-wear collectively comprise certain features which are believed to be distinguishable from its prior art.

First, the present face mask is configured to engage a head-wear through its rear portion via the extension of a fastener strap. This allows the decorative face mask to be positioned about the rear head portion of its wearer's head when the cap is worn frontward. As such, its wearer can fully enjoy the sporting event throughout the game without any obstruction to his or her face. Only when the wearer wishes to rally his or her favorite sports team, the wearer may simply reverse the cap around until the decorative face mask is moved away from his or her rear head portion and becomes positioned over his or her face. After the rallying period is over, the wearer may simply reverse the cap once again to place the face mask in its original position. Of course, this allows the wearer to enjoy the game without the face mask obstructing his or her view.

In order to facilitate such unique arrangement between the face mask and the head-wear, the present invention specifically applies hook and loop fasteners upon the end portions of the fastener strap. The hook and loop fasteners are essentially designed to extend through the rear crown portion of the head-wear and be attached with each other so as to engage the face mask thereto. By engaging the face mask in this manner, the face mask can be maintained about the rear crown portion which allows it to be mobilized along with the head-wear between the rear head portion and the face of the wearer. Note that such

attachment is a releasable attachment which allows the wearer to easily attach and detach the face mask to and from the rear crown portion of the head-wear.

As such, Applicant wishes to particularly emphasize, among other features, its decorative face mask which (1) engages through the rear crown portion of the head-wear by extending and releasably attaching the hook and loop fasteners provided on the end portions of its fastener strap, and (2) is rotatable about the wearer's head along with the head-wear between the rear head portion and the face of the wearer so as to be conveniently used only when rallying a sports team and unused during the rest of the sporting event.

Gomez & Koester In View of the Present Invention

Applicant limits its analysis primarily to Gomez and Koester as other prior art references, namely, Donahue and Casale, were cited for propositions unrelated to the above emphasized features of amended independent Claims 1 and 15. To the extent that Donahue and Casale are not believed to have been cited against any of the emphasized features of amended base Claims 1 and 15, Applicant respectfully submits that Gomez and Koester are the primary prior art of relevance to the amended independent claims pending in the present prosecution.

Gomez and Koester are not understood to disclose the present invention's specific combination of elements as recited

in amended independent Claims 1 and 15. More particularly, it is submitted that Gomez and Koester fail to teach or suggest a decorative face mask which (1) engages through the rear crown portion of the head-wear by extending and releasably attaching the hook and loop fasteners provided on the end portions of its fastener strap, and (2) is rotatable about the wearer's head along with the head-wear between the rear head portion and the face of the wearer so as to be conveniently used only when rallying a sports team and unused during the rest of the sporting event.

First, as the Examiner proposed in the last issued Office Action, Gomez "does not teach that each of the end portions include hook and loop fasteners sized and configured to attached with each other." (See, Office Action mailed July 23, 2003, page 3). Rather, the Examiner pointed to Koester in support of such proposition, stating that Koester's "end portions are selectively attachable both inside and outside of the headwear depending upon the needs of the wearer." Id.

However, Applicant respectfully disagrees with such proposition and points to Koester itself in support of its belief. Just by looking at Figure 5 of Koester, it appears that the hook and loop fasteners 19 are engaged around the wearer's neck, and not through his or her head-wear. This contention is supported by Koester's own patent specification which states

that "each terminal end of the neck strap 18 includes a cooperative third hook and loop fastener strip 19 to secure the strap 18 about an individual's neck." (Column 4, lines 20-23).

Rather, the application of hook and loop fasteners with respect to the head-wear in Koester is solely limited to its open mesh fabric sheet which is attached underneath the front portion of a cap. (See, Figure 3). Applicant respectfully submits that not only is such feature different but is completely opposite to the present invention which requires its face mask to be engaged through the head-wear (not mere attachment underneath) and further requires its face mask to be engaged with respect to the rear crown portion of the head-wear (not front portion).

Secondly, the Examiner seems to view that it "is well known in American sporting venues that when one wishes to rally their sporting team, one typically rotates a cap about their head so that the brim is facing to the rear." (See, Office Action mailed July 23, 2003, page 5). Based upon such view, the Examiner stated that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide Gomez's hat for the method of rallying a team by a wearer." Id. However, Applicant once again respectfully disagrees with the Examiner on this point.

More specifically, Gomez's invention is believed to be directed toward a totally different concept than the present invention. As understood, Gomez is all about providing "a most useful accessory for persons . . . to protect the wearer from the sun." (Column 9, lines 19-22). This is different from the present invention which is specifically provided to be used for rallying a team during a sporting event. Even the Casale reference which was briefly raised by the Examiner fails to relate to the objective and scope of the present invention. As the Examiner pointed out, Casale is solely focused to providing comfort or raising the aesthetic value. (See, Office Action mailed July 23, 2003, page 5).

Therefore, it is respectfully submitted that none of the relevant prior art references discloses a decorative face mask which (1) engages through the rear crown portion of the head-wear by extending and releasibly attaching the hook and loop fasteners provided on the end portions of its fastener strap, and (2) is rotatable about the wearer's head along with the head-wear between the rear head portion and the face of the wearer so as to be conveniently used only when rallying a sports team and unused during the rest of the sporting event. In this respect, it is further respectfully submitted that even when those references are combined, such emphasized feature of the present invention is not disclosed by the prior art references.

Applicant further makes the contention that although the prior art fails to disclose or make it obvious the unique bladder compartment of the present invention, Applicant respectfully submits that the disfavored hindsight construction of the cited references cannot be maintained. More specifically, the United States Court of Appeals for the Federal Circuit, in overturning a ruling by the Board of Patent Appeals and Interferences, held that "[W]hen a rejection depends on a combination of prior art reference, there must be some teaching, suggestion, or motivation to combine the references."¹ In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998) (citing In re Geiger, 815 F.2d 686, 688 (Fed. Cir. 1987)). The Federal Circuit further clarified this issue by stating that "when determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." Id. at 1356. As previously stated, the prior references are purposely limited to achieve each of its own

¹ The Federal Circuit explicitly stated that "an examiner must show an unrebutted *prima facie* case of obviousness." Rouffet, 149 F.3d at 1355. Moreover, "in the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent." Id. In other words, the Federal Circuit intentionally and unequivocally made it clear in the said case to resolve any previous confusion of what standard the Patent Examiners must abide to in making a 35 U.S.C. 103 rejection.

individualistic objective by their respective structural integrity. However, Applicant submits that the objective of the present invention is unique to its own, given the decorative face mask which (1) extends hook and loop fasteners through the head-wear's rear portion for engagement thereto, and (2) is specifically used for sport rallying purposes only. Therefore, especially in view of the belief that none of the cited prior art references suggest such features of the present invention, Applicant submits that the prior art lacks the sufficient motivation to combine with each other to create a case of obviousness.

However, even assuming arguendo, the Federal Circuit explicitly prohibited "the use of hindsight in the selection of references that comprise the case of obviousness." Id. at 1358 (citing In re Gorman, 933 F.2d 982, 986 (Fed. Cir. 1991)). More specifically, the Federal Circuit required that the examiner must show reasons that the person of ordinary skill in the art, when "confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." Id. at 1357. Thus, Applicant submits that the prior art currently cited by the Examiner should not serve as the foundation for the creation of such unique decorative face

mask of the present invention having specific features pursuant thereto.

Applicant respectfully submits that amended independent Claims 1 and 15 are allowable. Insofar as amended base Claims 1 and 15 are viewed to be allowable, their respective dependent claims are also believed to be allowable as they are further limitations thereof.

Request for Allowance

On the basis of the foregoing, Applicant respectfully submits that all the stated grounds of objections and rejections have been overcome, and that Claims 1-6 and 10-20 are in condition for allowance. An early Notice of Allowance is therefore respectfully requested.

Should the Examiner have any suggestions for expediting allowance of the application, the Examiner is invited to contact Applicant's representative at the telephone number listed below.

Respectfully submitted,

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